

This Opinion is Not a  
Precedent of the TTAB

Mailed: June 9, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Nanjing Linkwifi Network Technology Co., Ltd.*  
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Serial No. 79223580  
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M. Scott Alprin of Alprin Law Offices OC, for Nanjing Linkwifi Network Technology Co., Ltd.

Christopher Law, Trademark Examining Attorney, Law Office 103,  
Stacy Wahlberg, Managing Attorney.

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Before Thurmon, Lebow and Casagrande, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

Nanjing Linkwifi Network Technology Co., Ltd. (“Applicant”) filed a Request for Extension of Protection of an international registration pursuant to Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), for the mark WIFI MASTER KEY in standard characters (WIFI disclaimed) for the following goods and services:

Recorded computer software for searching for wireless internet connectivity, wirelessly connecting to the internet, and sharing access to wireless internet connectivity; downloadable software for searching for wireless internet connectivity, wirelessly connecting to the internet, and sharing access to wireless internet connectivity; downloadable computer software applications for

searching for wireless internet connectivity, wirelessly connecting to the internet, and sharing access to wireless internet connectivity; computer game software; data processing apparatus; data processing equipment in the nature of couplers; computer peripheral devices; electronic agendas; electronic tags for goods; electrostatic photocopiers; weighing apparatus and instruments; digital signs; computer networking and data communications equipment, namely, routers and other computer networking hardware; Global Positioning System (GPS) apparatus; intercommunication apparatus, namely, apparatus for transmission of communication; smart phones; audio and video receivers; photography cameras; surveying apparatus and instruments; telephone wires; integrated circuits chips; semi-conductors; electrical adapters; electronic transistors; video screens; electric apparatus for remote ignition, namely, remote control starters for vehicles; modems; electric batteries; transponders; video disks and video tapes with recorded animated cartoons; headphones; electric theft prevention installations, namely, theft alarms; 3D spectacles in International Class 9;

Wireless broadcasting; message sending; providing access to databases; computer aided transmission of messages and images; electronic bulletin board services; video-conferencing services; voice mail services; providing user access to global computer networks; communications by computer terminals; providing online forums for transmission of messages among computer users and mobile phone users in International Class 38; and,

Technical research in the field of wireless communications; information technology consultancy; consultancy in the design and development of computer hardware; software as a service (SaaS) services featuring software for searching for wireless internet connectivity, wirelessly connecting to the internet, and sharing access to wireless internet connectivity; computer technology consultancy; quality control for others; material testing; data conversion of computer programs and data, not physical conversion;

electronic data storage; industrial design in International Class 42.<sup>1</sup>

Registration was partially refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the two certification marks shown below that it is likely to cause confusion or mistake or to deceive:

WI-FI for "Computer hardware and peripherals, namely, wireless local area networking products" in International Class A;<sup>2</sup> and

 for "Computer hardware and peripherals, namely, wireless local area networking products" in International Class A.<sup>3</sup>

The Examining Attorney's partial refusal applies the following goods and services:

Recorded computer software for searching for wireless internet connectivity, wirelessly connecting to the internet,

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<sup>1</sup> Application Serial No. 79223580. The Application also identified services in International Classes 35 and 35 that are not subject to this appeal. The application was filed December 21, 2017, based on International Registration No. 1381364, with a priority claim date of August 30, 2016 pursuant to Section 67 of the Trademark Act, 15 U.S.C. § 1141(g). *See generally* The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("Madrid Protocol") and Madrid Protocol Implementation Act of 2002, Pub. L. 107-273, 116 Stat. 1758, 1913-1921 ("MPIA").

Citations to the prosecution file refer to the USPTO's Trademark Status & Document Retrieval ("TSDR") system in .pdf format. Citations to briefs refer to the actual page number, if available, as well as TTABVUE, the Board's online docketing system. The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

<sup>2</sup> Registration No. 2525795; renewed April 23, 2022. This registration is for a typed mark, which is equivalent to a standard character mark. "Prior to November 2, 2003, 'standard character' drawings were known as 'typed' drawings. ... A typed mark is the legal equivalent of a standard character mark." TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 807.03(i) (July 2022). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012).

<sup>3</sup> Registration No. 2523241; renewed April 23, 2022.

and sharing access to wireless internet connectivity; downloadable software for searching for wireless internet connectivity, wirelessly connecting to the internet, and sharing access to wireless internet connectivity; downloadable computer software applications for searching for wireless internet connectivity, wirelessly connecting to the internet, and sharing access to wireless internet connectivity; computer peripheral devices; electronic tags for goods; computer networking and data communications equipment, namely, routers and other computer networking hardware; intercommunication apparatus, namely, apparatus for transmission of communication; smart phones; integrated circuits chips; semi-conductors; electrical adapters; electronic transistors; modems; transponders, in International Class 9;

Wireless broadcasting; message sending; providing access to databases; computer aided transmission of messages and images; video-conferencing services; voice mail services; providing user access to global computer networks; communications by computer terminals, in International Class 38; and,

Technical research in the field of wireless communications; information technology consultancy; consultancy in the design and development of computer hardware; software as a service (SaaS) services featuring software for searching for wireless internet connectivity, wirelessly connecting to the internet, and sharing access to wireless internet connectivity; computer technology consultancy; quality control for others; material testing; data conversion of computer programs and data, not physical conversion; electronic data storage; industrial design, in International Class 42.<sup>4</sup>

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<sup>4</sup> 23 TTABVUE 4 (Examining Attorney brief); January 16, 2020 Office Action. To be clear, this appeal does not extend to any of the services Applicant identified in International Classes 35 or 36. Nor does it cover all the goods in International Class 9 or services in International Class 38. We list the remaining goods and services at the end of this decision, for clarity.

Applicant appealed and filed a request for reconsideration which was denied. The appeal is now fully briefed. We affirm the partial refusal to register based on the cited word mark WI-FI.

### **I. Likelihood of Confusion – Applicable Law**

We base our determination of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *du Pont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). However, “each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

In applying the *du Pont* factors, we bear in mind the fundamental purposes underlying Section 2(d), which are to prevent confusion as to source and to protect registrants from damage caused by registration of confusingly similar marks. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *du Pont*, 177 USPQ at 566. We have considered each *du Pont* factor that is relevant and of record. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d

1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

Varying weights may be assigned to each *du Pont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations in most cases are the similarities between the marks and the similarities between the goods or services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *du Pont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”)).

As noted earlier, the two cited registrations are for certification marks. While we use the same “test for determining likelihood of confusion with respect to certification marks,” *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2049 (TTAB 2012), there may be differences in the application of the *du Pont* factors because of the nature of the cited mark. A certification mark is used by persons other than the registrant to certify something about the user’s goods or services.<sup>5</sup> This characteristic of certification

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<sup>5</sup> *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*3 (TTAB 2020) (citing Section 4 of the Trademark Act, 15 U.S.C. § 1054). 15 U.S.C. § 1127 provides:

marks impacts our analysis in at least two ways. First, while confusion as to source is usually the focus of our analysis under Section 2(d), when a certification mark forms the basis for such a refusal, the question is often whether consumers will mistakenly believe the applicant's goods or services have been certified. *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*7 (“because a certification mark may not be used by the owner of the mark, but is instead used by authorized users, the [likelihood of confusion] analysis is based on the authorized users’ goods ...”). In this case, that would include makers of “computer hardware and peripherals, namely, wireless local area networking products” that have been certified by the owner of the WI-FI certification mark.<sup>6</sup> *See, e.g., Motion Picture Ass’n of Am., Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1562 (TTAB 2007) (“Thus, for purposes of our likelihood of confusion analysis, we must determine whether applicant’s ‘men’s and

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The term “certification mark” means any word, name, symbol, or device, or any combination thereof—

(1) used by a person other than its owner, or

(2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

<sup>6</sup> Applicant misses this important point when it argues that “it is not realistic to believe that consumers would think that a ‘certified’ device would emanate from the same source as the ‘certifier.’” 20 TTABVUE 11. The owner of a certification mark may not use the certification mark as a source indicator, or else the mark could be subject to cancellation. *See, e.g., Midwest Plastic Fabricators, Inc. v. Underwriters Labs., Inc.*, 906 F.2d 1568, 15 USPQ2d 1359, 1361 (Fed. Cir. 1990).

ladies' shirts, pants, ladies' dresses, shorts and jackets' are related to the 'entertainment services rendered through the medium of motion pictures' provided by users of opposer's RATED R certification mark.”).

The second impact that results from the unique character of a certification mark is that third-party evidence may not show weakness of the mark. A listing of third-parties who use WIFI (with or without a hyphen) as part of their trademarks does not tell us whether the parties' uses are certified by the owner of the WI-FI certification mark. Without that information, we cannot tell whether a particular mark shows strength or weakness of the certification mark. If many such uses are certified and only a relatively small number are not certified, that might indicate the certification mark is widely-recognized within the relevant industry and is a strong mark. *Compare with In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*12 (holding that the geographic nature of a geographic certification mark does not render the mark “weak’ or subject to a narrower scope of protection”).

## **II. Likelihood of Confusion - Analysis**

### **A. Strength of the Cited Mark**

We begin our analysis with the sixth *du Pont* factor—the strength of the cited mark. We start here because of Applicant's focus on this issue. Applicant argues that because the term WIFI (with or without the hyphen) is used by many third-parties, this term is diluted and weak.<sup>7</sup> Applicant also stresses that it disclaimed “WIFI” in

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<sup>7</sup> 20 TTABVUE 7-8. *See also* Response to Office Action dated February 14, 2019, TSDR at 2-7 (providing a list of 34 trademark registrations that include WIFI and indicating whether this term was disclaimed); Response to Office Action dated August 16, 2019.

its application and disclaimed terms are less likely to contribute to a likelihood of confusion.<sup>8</sup>

While Applicant has identified many alleged uses of WIFI in trademarks and other contexts (e.g., hotels offering WIFI service), none of this evidence indicates whether the uses are certified by the owner of the WI-FI certification mark. Without such information, the evidence is ambiguous because we cannot determine whether any particular use contributes to or detracts from the strength of the WI-FI certification mark, which by definition will be used by parties other than the owner/certifier. In addition, many of the alleged uses do not involve makers of “computer hardware and peripherals,” which are the types of goods certified under the WI-FI mark.

“Applicant respectfully submits that it is irrelevant whether the cited Registrant has certified the devices that provide or use the WiFi services referenced in the above-identified examples of use.”<sup>9</sup> We disagree because if most of the listed uses of the relevant goods are certified, then these uses would tend to show strength of the mark, not weakness. Without such information, the evidence Applicant submitted regarding third-party uses is of little probative value.

In some situations, a long list of third-party registrations or third-party uses may show weakness in a cited mark. *See, e.g., Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d

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<sup>8</sup> 20 TTABVUE 7.

<sup>9</sup> *Id.* at 6.

1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). This is not such a case. Because the cited mark is a certification mark, we need to know which third-party uses are certified and which are not. In the cases that gave weight to long lists of third-party registrations or uses, this ambiguity did not exist.

Applicant equates the ubiquity of WI-FI communications with weakness of the cited WI-FI certification mark. There is, however, no evidence supporting such a connection. Perhaps it is because of the certification mark use that the ubiquitous WI-FI communications work well for so many of us. Indeed, the evidence that Applicant relies on to argue for weakness may be evidence of strength. It is impossible for us to make a finding on the strength of the cited mark given the record before us. We treat this factor as neutral in our likelihood of confusion analysis.

### **B. Similarity of the marks**

We compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

Both marks at issue here begin with the term WI-FI, either with or without a hyphen. Applicant’s WIFI MASTER KEY mark subsumes the cited WI-FI mark. These facts make the marks more similar. See *Palm Bay Imps., Inc. v. Veuve Clicquot*

*Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”).

We note that “the presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260-61 (Fed. Cir. 2010) (finding ML in standard characters confusingly similar to ML MARK LEES in stylized form). *See also Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (finding STONE LION CAPITAL confusingly similar to LION and LION CAPITAL); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN likely to be confused with TITAN); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1367 (TTAB 2007) (affirming refusal to register CLUB PALMS MVP based on prior registration of MVP, finding consumers “likely to believe that the CLUB PALMS MVP casino services is simply the now identified source of the previously anonymous MVP casino services”); *In re Chica Inc.*, 84

USPQ2d 1845, 1848-49 (TTAB 2007) (affirming refusal to register CORAZON BY CHICA & Design based on a registration of CORAZON in stylized format, stating “to many consumers, applicant’s mark for the identical word ‘Corazon’ followed by the phrase ‘BY CHICA’ will simply be viewed as the identification of the previously anonymous source of the goods sold under the mark CORAZON”).

We find the marks at issue here are highly similar. Consumers familiar with the WI-FI certification mark are likely to view Applicant’s mark as a mere variation, or perhaps as a line extension of the known certification mark. Moreover, because Applicant’s mark fully subsumes the registered WI-FI mark, albeit without the hyphen, consumers familiar with the certification mark are likely to believe Applicant’s goods have been certified. *The Pierce-Arrow Society v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at 24 (TTAB 2019) (“The presence of the hyphen in Applicant’s mark does not distinguish it from Opposer’s mark.”).

Applicant argues that it disclaimed “WIFI” and that disclaimed terms should be given less weight in the evaluation of the similarity of the marks. We agree with this general proposition. *See, e.g., Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (“Given the descriptive nature of the disclaimed word ‘Technologies,’ the Board correctly found that the word ‘Packard’ is the dominant and distinguishing element of PACKARD TECHNOLOGIES.”). *See also Double Coin Holdings, Ltd. v. Tru Dev.*, 2019 USPQ2d 3373409 at \*7 (TTAB 2019) (“Here, ROAD WARRIOR [for tires] looks, sounds, and conveys the impression of being a line extension of WARRIOR.”); *In re Risesmart, Inc.*, 104 USPQ2d 1931,

1935 (TTAB 2012) (“We find that the marks would convey the same connotation with regard to the word ASSURANCE and the additional words in applicant’s [marks TALENT ASSURANCE and JOB ASSURANCE] simply provide more information as to the nature of the services.”); *Anheuser-Busch, LLC v. Innovopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1825 (TTAB 2015) (“the additional, generic word WINE in Applicant’s mark [WINEBUD] is insufficient to distinguish it from Opposer’s BUD mark”).

While Applicant’s disclaimer of WIFI suggests the term is less distinctive than the remainder of its mark, this term is not disclaimed in the cited mark; it is the *entire* cited mark. And within the context of the WI-FI certification mark, the term takes on a specific meaning—that is, that the goods or services have been certified to meet certain standards. The fact that *Applicant* disclaimed WIFI in its application does not eliminate the risk that consumers will believe this term means Applicant’s goods have been certified. *See, e.g., In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“The technicality of a disclaimer in National’s application to register its mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed during prosecution of the trademark application at the PTO.”) (footnote omitted).” In this case, we do not believe the disclaimer reduces the similarity of the marks, in part because of the role played by the cited certification mark. The marks are similar and this makes confusion more likely.

### C. Similarity of the Goods and Trade Channels

“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.” *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Stone Lion*, 110 USPQ2d at 1161; *Paula Payne Prods. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). We group these two *du Pont* factors because of the shared focus on the identification of the goods.<sup>10</sup>

The WI-FI registration identifies “Computer hardware and peripherals, namely, wireless local area networking products.”<sup>11</sup> We noted above that the proper comparison is between Applicant’s goods and services and the goods and services of certified users of the WI-FI mark. Unfortunately, we cannot determine from the evidence of record which uses are certified. But we know from the certification mark registration that certified users provide “computer hardware and peripherals” involved in transmitting and receiving WI-FI signals. So, we look for similarities between these goods and the goods and services covered by the refusal at issue in this appeal. *In re Accelerate s.a.l.*, 101 USPQ2d at 2051 (“applicant’s use of the mark

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<sup>10</sup> Our analysis here covers the second and third *du Pont* factors: “The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;” and “The similarity or dissimilarity of established, likely-to-continue trade channels.” *du Pont*, 177 USPQ at 567.

<sup>11</sup> Registration No. 2525795.

COLOMBIANO COFFEE HOUSE for ‘providing of food and drink’ is likely to cause confusion with the registered geographic certification mark COLOMBIAN for coffee.”).

The refusal addressed multiple goods in International Class 9, including: “computer networking and data communications equipment, namely, routers and other computer networking hardware.”<sup>12</sup> The goods also include “computer software for searching for wireless internet connectivity, wirelessly connecting to the internet, and sharing access to wireless internet connectivity,”<sup>13</sup> making clear that the goods relate directly to wireless networking products. We find the refused class 9 goods are identical in part to those in the cited registration.

The class 38 and 42 services subject to the refusal are not “hardware and peripherals,” and thus, are not identical to the goods identified in the cited registration. But the services at issue here are related to the goods identified in the cited WI-FI registration. For example, the class 38 services include: “wireless broadcasting; message sending; providing access to databases; computer aided transmission of messages and images; providing user access to global computer networks,”<sup>14</sup> all of which are closely related to the goods identified in the WI-FI certification mark registration. The hardware identified in the cited registration

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<sup>12</sup> 23 TTABVUE 4 (Examining Attorney brief).

<sup>13</sup> *Id.*

<sup>14</sup> *Id.*

would be used to carry out these services, and that relationship is enough to make confusion more likely.

The same is true of Applicant's class 42 services, which include: "Technical research in the field of wireless communications; software as a service (SaaS) services featuring software for searching for wireless internet connectivity, wirelessly connecting to the internet, and sharing access to wireless internet connectivity."<sup>15</sup> One means of "wireless internet connectivity" is via WI-FI using the goods identified in the WI-FI registration. So, again, the services identified by Applicant are directly related to the goods in the cited registration. This connection makes confusion more likely.

The goods and services need not be identical or even competitive to support a finding that confusion is likely. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods or] services emanate from the same source." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). In addition, the Examining Attorney need not prove, and we need not find, similarity as to each good listed in the application. "It is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the

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<sup>15</sup> *Id.*

identification of goods within a particular class in the application.” *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

The Examining Attorney submitted internet evidence showing that the relevant goods are advertised together or sold by each of a number of third-parties, including: Connectivity, HP, Linksys, Sale Stores, Texas Instruments, Infineon, HughesNet, and Vesper.<sup>16</sup> This evidence further supports our finding that the goods and services identified in the Application are highly similar or related to the goods in the cited WI-FI registration.

Finally, we note that Applicant did not challenge the Examining Attorney’s conclusion that the goods and services are similar, either here or during prosecution of the application. We therefore find that Applicant conceded that the similarity of the goods factor supports a finding of likelihood of confusion.

This brings us to the similarity or dissimilarity of established, likely-to-continue trade channels, the third *du Pont* factor. The proper comparison is between the trade channels likely used by parties who make and sell certified WI-FI goods and the trade channels likely used by Applicant. It would make little sense to speak of the trade channels of a certification entity, because its product is certification, not the certified goods. We have found some of the class 9 goods in the pending application are identical, in part, to the goods in the cited registration. It follows, therefore, that these goods are likely to travel in the same or similar trade channels. *Cunningham v. Laser*

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<sup>16</sup> March 25, 2019 Office Action, TSDR 2-37.

*Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (affirming Board finding that where the identification is unrestricted, “we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods”); *Cai*, 127 USPQ2d at 1801. We further find that the services subject to the refusal are also likely to flow through the same trade channels because these services make use of the class 9 goods to perform the recited services. When goods and services are provided together, it follows that they are likely to flow through the same trade channels.

#### **D. Other Considerations<sup>17</sup> – Inconsistency at the PTO**

Applicant complains that the Office is not being consistent in its examination of marks that include “wi-fi” as part of the mark. We agree, to an extent, with Applicant. The Office has registered many “wi-fi” marks despite the existence of the registered WI-FI certification marks. “The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement, ... even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.” *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016). However, the refusal to register in this case is well-supported and must be affirmed.

Applicant filed two applications and only one of them was finally refused based on the WI-FI certification marks.<sup>18</sup> The other application involved the mark

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<sup>17</sup> We evaluate Applicant’s inconsistency arguments under the 13<sup>th</sup> *du Pont* factor which allows consideration of other facts that may bear on the likelihood of confusion analysis.

<sup>18</sup> 20 TTABVUE 12-14.

WIFIMASTER for similar goods and services. That application was allowed and the mark is now registered. A Section 2(d) refusal was issued based on the WI-FI certification marks, but that refusal was withdrawn after Applicant amended its application. The same approach did not work in the current application.<sup>19</sup>

We acknowledge that it is possible that the two applications were treated inconsistently. The USPTO examines hundreds of thousands of trademark applications every year. It has an examining corps that consists of hundreds of Examining Attorneys. Within such a large operation, inconsistencies arise. As the Board tasked with handling appeals from refusals to register, we can and must address only the matters before us, i.e., appeals from refusals. We do not review individual Examining Attorneys' allowances. In this instance, that requires that we affirm this refusal, despite Applicant's argument that it is inconsistent with Applicant's related and now-registered WIFIMASTER mark.

### **III. Summary of the *du Pont* Factors**

We have carefully considered all of the evidence made of record, as well as all arguments related thereto. With highly-similar marks and identical or closely-related goods and services marketed in the same trade channels, consumer confusion is likely. In this instance, that confusion may take the form of consumers mistakenly believing that Applicant's goods and services have been certified by Registrant.

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<sup>19</sup> There were different Examining Attorneys assigned to Applicant's two applications. *Id.* Applicant, not surprisingly, argues the Examining Attorney responsible for its other application got it right and that the Examining Attorney handling this application got it wrong. We offer no view on whether Applicant's WIFIMASTER mark should have been registered. As noted above, we must consider each case on its own unique facts.

Applicant's evidence of third-party use has not shown that the cited WI-FI mark is weak. And while Applicant has noted inconsistencies in the examination of its two related applications, we must decide this appeal on its own merits. When that is done, it is clear the partial Section 2(d) refusal must be affirmed.

**Decision:** The partial Section 2(d) refusal is affirmed, and applies to goods in International Class 9 and services in International Classes 38 and 42. The application will proceed with all services in International Classes 35 and 36, plus the following goods in International Class 9:

computer game software; data processing apparatus; data processing equipment in the nature of couplers; electronic agendas; electrostatic photocopiers; weighing apparatus and instruments; digital signs; Global Positioning System (GPS) apparatus; audio and video receivers; photography cameras; surveying apparatus and instruments; telephone wires; video screens; electric apparatus for remote ignition, namely, remote control starters for vehicles; electric batteries; video disks and video tapes with recorded animated cartoons; headphones; electric theft prevention installations, namely, theft alarms; 3D spectacles.

In addition, the following services in International Class 38 are not subject to this appeal, so the application will proceed with these services, as well:

electronic bulletin board services; providing online forums for transmission of messages among computer users and mobile phone users.